

REMARKS

Applicants have studied the Office Action dated February 22, 2005. In response to the reopening of prosecution, the Applicants have elected to file this reply under 37 C.F.R. 1.111 and have made amendments to the claims. No new matter has been added. It is submitted that the application, as amended, is in condition for allowance. By virtue of this amendment, Claims 1-7, 10-19, 22-28 and 30-39 remain pending. Claims 8-9, 20-21 and 29 have been cancelled without prejudice. Claims 1, 15, 19, 22-23 and 25 have been amended and new claims 35-39 have been added. Reconsideration and further examination of the pending claims in view of the above amendments and the following remarks is respectfully requested.

New Claims

The Applicants have added new claims 35-39. Support for claims 35-37 is found in the specification at, for example, page 23, line 15 through page 24, line 5. No new matter has been added. Support for claims 38 and 39 is found in the specification at, for example, page 18, lines 1-12 and FIG. 4. No new matter has been added by this amendment.

Rejection under 35 U.S.C. §102(b)

The Examiner rejected claim 1-30 and 34 under 35 U.S.C. 102(b) as being anticipated by *Holehan* (U.S. Patent No. 6,043,809) (Hereinafter "*Holehan*"). The Examiner cites 35 U.S.C. § 102(b) and a proper rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected claims.¹

¹ See MPEP §2131 (Emphasis Added) "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim."

To begin, the Holehan reference is directed to "one or more scroll bar sensors for scrolling up and down and left and right in a document." Holehan, Abstract. The teachings of Holehan are limited to having separate sensors that are either "up and down scroll bar sensors 122, 124" or "left and right scroll bar sensors." Holehan, column 3, lines 45-48. Although Holehan describes the scroll bar sensors as being "disposed around" or "wrapping around" edges 134, the Applicants point out that the edges 134 around with these scroll bar sensors are disposed or wrapped are the edges that form the transition between a face of a device, such as top surface 132, and an outside edge, such as the front surface 128 of the Holehan patent. Holehan, column 3, lines 45-55.

The Applicants have amended independent claim 1 to recite, *inter alia*:

a housing comprising a face, a back and an outside edge,
the back being located substantially behind the face,
the outside edge comprising at least two adjoining sections
and at least one corner edge wherein two adjoining sections of the
outside edge are joined at an angle by each of the at least one
corner edge;
at least one touchpad that is continuously disposed along the at
least two adjoining sections and the at least one corner edge of the
outside edge of the housing in order to form a single touchpad along the at
least two non-parallel sections and the at least one corner edge.

Support for the amendments to claim 1 are supported by the specification at, for example, page 17, lines 1-17. No new matter has been added by this amendment. The Applicants assert that this recited structure substantially differs from the teachings of the Holehan reference. The above recited structure defines a face and a back of a housing, as well as an outside edge that have specified relationships. The above recited structure then specifies at least one touchpad that is disposed on specified components of the housing. The Applicants assert that the device specified by amended claim 1 distinguishes over the teachings of Holehan because Holehan does not teach, anticipate, or suggest "at least one touchpad that is continuously disposed along the at
least two adjoining sections and the at least one corner edge of the outside edge of the

housing in order to form a single touchpad along the at least two non-parallel sections and the at least one corner edge" in the context of amended independent claim 1.

With regards to claim 2, the Applicants respectfully assert that Holehan does not teach, anticipate, or suggest "wherein the at least one touchpad extends substantially about a perimeter of the housing" as is recited by claim 2. The Applicants respectfully point out that the adverb "about" is defined as "1) on every side; all around." *Webster's New World College Dictionary*, 2002, page 4. The Applicants use of this term in their specification is consistent with this dictionary definition. The specification describes touchpads as extending "substantially about" in their specification in describing touchpads being disposed substantially about a perimeter 110 along an outside edge 104. Specification, page 13, lines 13-16. In contrast to the structure described by claim 2, the teachings of Holehan are limited to having discreet scroll bar sensors that are located at various locations around a keyboard. The Applicants point out, for example, that the Holehan reference never shows or suggests that a touchpad (or a scroll bar sensor) is located at, for example, the "top" of the keyboard 120 in their example. The Holehan reference further has no teachings of a touchpad located at corners of the keyboard 120. The teachings of Holehan therefore differ significantly from the specification of claim 2 that the at least one touchpad "extends substantially about a perimeter of the housing."

With regards to claim 3, the Applicants fail to see where the Holehan reference teaches that "the perimeter of the housing is rounded." The Examiner cites FIG. 1 of Holehan as a teaching of this limitation. Office Action dated February 22, 2005, page 3, second paragraph. The Applicants traverse the Examiner's assertion with respect to this teaching and respectfully submit that the line figures used by Holehan only illustrate sharp edges for all surfaces. See, for example, Holehan, FIG. 1. The Applicants further point out that "the perimeter" specified in claim 3 is defined in claim 2, from which claim 3 depends, as "the at least one touchpad extends substantially about a perimeter of the housing." The Applicants point out that the edges around which the scroll bar sensors of the Holehan reference wrap are sharp edges and not rounded in any way.

With regards to claims 5 and 30, the Applicants traverse the Examiner's assertion that Holehan discloses "the at least one touchpad comprises at least an inherent texture for providing a tactile feedback to the user." Office Action dated February 22, 2005, page 3, fourth paragraph. The Applicants point out that the Examiner did not cite a specific portion of the Holehan reference that teaches the limitation contained in claims 5 and 30. Office Action dated February 22, 2005, page 3, fourth paragraph. The Applicants respectfully assert that the Holehan reference does not contain any teaching or suggestion that the scroll bar sensors of that reference have any type of "inherent texture for providing a tactile feedback to the user" as is recited for claims 5 and 30.

With regards to claim 7, the Applicants have amended claim 7 to specify that "a sliding contact with the at least one touchpad causes an adjustment of an operating variable unrelated to graphical object display." Support for this amendment is found in the specification at, for example, page 20, line 20 through page 21, line 3. No new matter has been added by this amendment. The Applicants respectfully assert that the Holehan reference is limited to using scroll bar sensors to control a computer display, and more specifically to control scrolling of the display.

With respect to claim 10, the Applicants traverse the Examiner's assertion that "Holehan discloses that the electronic device of claim 1, wherein the housing comprises a display having a display screen." Office Action dated February 22, 2005, page 4, first paragraph, emphasis added. The "housing" referred to in claim 10 is the housing defined within claim 1, from which claim 10 depends. As described above, this housing is specified in claim 1 to have "at least one touchpad that is continuously disposed" as is specified in claim 1. The Applicants respectfully point out that the Holehan reference teaches, in FIG. 1 for example, a display 110 that is contained an enclosure that is distinctly separate from the enclosure 120 on which the scroll bar sensors are mounted. In fact, the Holehan reference describes this enclosure as a keyboard 120. Holehan, column 3, lines 36-37. The only scroll bar sensors discussed in the Holehan reference

are mounted on the keyboard in both FIGs 1 and 2, and no scroll bar sensors are shown to be mounted to monitor. This is consistent with the teachings of Holehan, which are directed to "scroll bar sensors" used as user input devices to scroll a window, usually while typing text on a keyboard.

The Applicants have amended claim 15 to more clearly define an aspect of the present invention. Support for this amendment is found in the specification at, for example, page 19, line 1-11. No new matter has been added by this amendment. With respect to amended dependent claim 15, the Applicants assert that the Holehan reference does not teach, anticipate or suggest "at least one touchpad" that "comprises a plurality of sections and each section of the at least one touchpad controls movement in one of at least two different one-dimensional axes" in the context set forth in dependent claim 15. The Applicants point out that the teachings of Holehan are limited to having separate "scroll bar sensors" for each dimension. Holehan, column 3, lines 40-52.

With respect to claim 18, the Applicants traverse the Examiner's assertion that Holehan "should have an inherent comprises three-dimensional manipulation of objects displayed on the screen." Office Action dated February 22, 2005, page 5, first full paragraph. The Applicants point out that the teachings of Holehan are limited to "scroll bar sensors" that are used to scroll a graphical display in two dimensions. Holehan, column 2, lines 46-55. The Applicants respectfully assert that Holehan does not teach, anticipate, or suggest "manipulation of objects displayed on the display screen" in any other dimension other than the vertical (up and down scroll bar sensors) or horizontal (left and right scroll bar sensor). Holehan, column 3, lines 42-52.

The Applicants point out that there is also no teaching or suggestion in the Holehan reference of how an operator would manipulate objects displayed on the display screen in any dimension other than the two dimensions disclosed by the Holehan reference. The teachings of Holehan are limited to "scroll bar sensors" that are used to "scroll up and down and left and right through a document." Holehan, Column

4, lines 20-22. As such, the Holehan reference is not able to inherently teach, anticipate, or suggest three-dimensional manipulation of the present invention. "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." MPEP §2112 (emphasis in original). The MPEP further notes that:

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'"

Id., citing *In re Roberson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-54 (Fed. Cir. 1999)

With regards to amended independent claim 19, the Applicants have amended this claim to more clearly describe the operation of an aspect of the present invention. Dependent claims 22 and 23, which depend from claim 19, have also been amended. Support for these amendments is found in the specification at, for example, page 24, line 16 through page 25, line 5. No new matter has been added by these amendments. Amended independent claim 19 recites "simultaneously touching at least two touchpads that are each disposed about an outside edge of a housing." The Applicants assert that the Holehan reference does not teach, anticipate, or suggest this aspect of the present invention. Further, especially when considering claim 19 as a whole, the Holehan reference does not teach or anticipate, in combination with the other limitations of claim 19, "transmitting an electrical signal upon detecting the simultaneous touching to a control circuit, wherein the control circuit acts upon the electrical signal and controls manipulation of the at least one object in at least two dimensions, wherein each of the at least two dimensions is manipulated in response to touching a corresponding touchpad within the at least two touchpads."

With regards to amended independent claim 24, the Applicants fail to see where the Holehan reference discloses "using tactile feel to position at least one finger along the outside edge of the housing" as is set forth in claim 24. Office Action dated

February 22, 2005, page 6, top of page. The Examiner did not cite a portion of the Holehan reference which teaches this aspect of the present invention. The Applicants submit that the Holehan reference does not discuss or indicate any type of "tactile feel" and therefore cannot disclose this limitation.

The Applicants have amended claim 25 to more specifically describe an aspect of the present invention. Support for this amendment is found in the specification at, for example, page 24, lines 5-14. No new matter has been added by this amendment. With regards to amended independent claim 25, the Applicants assert that the teachings of the Holehan reference are limited to "up and down scroll bar sensors" and a "left and right scroll bar sensor." Holehan, column 3, lines 43-52. The Applicants assert that the teachings of the Holehan reference, taken either alone or in any combination with the other cited prior art of references, fails to teach, anticipate, or suggest the combination of limitations recited for amended independent claim 25, particularly when the claim is considered as a whole.

Additionally, the Applicants note that dependent claims 2-7, 10-18, and 35-36 and 38 depend directly or indirectly from independent claim 1, dependent claims 22-24 and 39 depend from independent claim 19, and dependent claims 26-28, 30-34 and 37 depend from independent claim 25, respectively. As discussed above, amended independent claims 1, 19 and 25 distinguish over the Holehan reference. Since dependent claims include all of the limitations of the independent claims from which they depend, the Applicants further assert that amended dependent claims 2-7, 10-18, 22-24, 26-28, 30-39 also distinguish over the Holehan reference as well. Therefore, Applicants respectfully assert that the Examiner's rejection under 35 U.S.C. §102(b) should be withdrawn.

Rejection under 35 U.S.C. §103(a)

The Examiner rejected Claims 31-33 under 35 U.S.C. § 103(a) as being unpatentable over *Holehan* (U. S. Patent No. 6,043,809) (hereinafter "Holehan") in view of *Anderson* (U. S. Patent No. 6,509,847) (hereinafter "Anderson"), and in view of

Caldwell et al. (U. S. Patent No. 5,867,111) (hereinafter "Caldwell"). A proper rejection under 35 U.S.C. §103 expressly requires that obviousness or non-obviousness be determined for the claimed subject matter "as a whole," and the key to proper determination of the differences between the prior art and the present invention is giving full recognition to the invention "as a whole."

The Applicants point out that dependent claims 31-33 depend from independent claim 25. As discussed above, amended independent claim 25 distinguishes over the Holehan reference. Furthermore, the Applicants assert that neither the Anderson reference, which is directed to a pressure password input device and method and which was cited for its teaching of an analog-to-digital converter, nor the Caldwell reference, which is directed to a touch control system and which was cited for a signal amplifier coupled to a touch input, taken either alone or in any combination with one another, with the Holehan reference, or with any other cited prior art references, teach the combination of limitations in claims 31-33, which include the limitations set forth in independent claim 25 from which these claims depend. Since dependent claims include all of the limitations of the independent claims from which they depend, the Applicants assert that dependent claims 31-33 also distinguish over the Holehan, Anderson and Caldwell references, taken either alone or in any combination, as well. Therefore, Applicants respectfully assert that the Examiner's rejection under 35 U.S.C. §103 over Holehan in view of Anderson and in view of Caldwell should be withdrawn.

Conclusion

The foregoing is submitted as full and complete response to the Official Action mailed February 22, 2005, and it is submitted that Claims 1-7, 10-19, 22-28 and 30-39 are in condition for allowance. Reconsideration of the rejection and objection are requested. Allowance of Claims 1-7, 10-19, 22-28 and 30-39 is earnestly solicited.

The present application, after entry of this amendment, comprises thirty-four (34) claims, including three (3) independent claims. Applicants have previously paid for

thirty-four (34) claims, including three (3) independent claims. Applicants, therefore, believe that an additional fee for claims is currently not due.

If the Examiner believes that there are any informalities that can be corrected by Examiner's amendment, a telephone call to the undersigned at (561) 989-9811 is respectfully solicited.


The Commissioner is hereby authorized to charge any fees that may be required or credit any overpayment to Deposit Account 09-0441.

In view of the preceding discussion, it is submitted that the claims are in condition for allowance. Reconsideration and re-examination is requested.

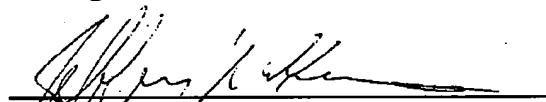
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